

ESTTA Tracking number: **ESTTA651835**

Filing date: **01/23/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215512
Party	Plaintiff BODY VIBE INTERNATIONAL, LLC
Correspondence Address	THOMAS P PHILBRICK ALLMARK TRADEMARK 2089 AVY AVE MENLO PARK, CA 94025 UNITED STATES tom@allmarktrademark.com, allmarktrademark@gmail.com
Submission	Opposition/Response to Motion
Filer's Name	Thomas P. Philbrick
Filer's e-mail	tom@allmarktrademark.com, allmarktrademark@gmail.com
Signature	/Thomas P. Philbrick/
Date	01/23/2015
Attachments	opposition to Applicant's motion for leave to amend.pdf(966668 bytes ) Exhibit A to opposition to motion to amend.pdf(365800 bytes ) Exhibit B cover sheet.pdf(49759 bytes ) Reply to Mark Hubert letter dated Dec 30th re amended pleading and Rule 11 01092015.pdf(420447 bytes ) email cover sheet for Jan 9 2015 reply re Rule 11.pdf(106140 bytes ) certificate of service for opposition to motion for leave to amend.pdf(112703 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application serial no. 85966358 (DR. VAPE)

Filed on June 21, 2013

BODY VIBE INTERNATIONAL, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91215512
v.	)	
	)	
Cox, David	)	
	)	
	)	
Applicant.	)	
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Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND  
ANSWER (filed on 01/13/2015) TO OPPOSER'S FIRST AMENDED OPPOSITION**

BODY VIBE INTERNATIONAL, LLC, a limited liability company legally organized under the laws of New Mexico, with a principal place of business of 11445 E. Via Linda, Suite 2626, Scottsdale, AZ 85259, (hereinafter "Opposer"), hereby submits the following opposition to Applicant's motion for leave to amend his first amended answer to Opposer's First Amended Opposition. (Said motion was filed with the TTAB on January 13, 2015 so this opposition/response thereto is timely.) Via his motion, Applicant is playing games (to put it mildly) with the TTAB litigation system and the motion should therefore be denied so that the Board may rule upon Opposer's Motion for Rule 11 Sanctions filed concurrently herewith.

### A. Background/Procedural History

On March 19, 2014, Opposer filed this opposition proceeding against serial number 85966358 for the mark DR. VAPE. (hereinafter “Applicant’s Mark”) Applicant filed his answer to the original notice of opposition on April 24, 2014 which included a statement in paragraph 12 that “Applicant David Cox has been selling his **cannabis-associated** vaporizer in interstate commerce.” (bold and underlining added) Realizing his inadvertent disclosure that Applicant’s Mark is possibly not in lawful use in commerce, Applicant promptly filed an amended answer as a matter of right on April 28, 2014, just 4 days after his original answer filing. On July 25, 2014, after discovering additional information about the Applicant, Opposer filed a motion to amend the notice of opposition to add a claim for “not in lawful use in commerce.” Opposer’s motion to amend the opposition was granted by order from the Board on October 3, 2014. Applicant subsequently filed his answer to Opposer’s First Amended Notice of Opposition on October 17, 2014. After carefully reviewing and considering Applicant’s October 17, 2014 answer to amended opposition, Opposer served a Rule 11 Motion for sanctions on Applicant via 1<sup>st</sup> class mail on December 19, 2014. (A copy of Opposer’s Rule 11 Motion was attached to Applicant’s Motion for Leave to amend) With the 21 day “safe harbor” provided under Rule 11, (“plus 5 days” due to service via 1<sup>st</sup> class mail), the first day Opposer could have possibly filed its Rule 11 motion at the TTAB was on or about January 14<sup>th</sup> or 15<sup>th</sup> of 2015. Via this attempted motion to amend his pleading, **Applicant is attempting to circumvent the Board’s Rule 11 procedures by filing his motion one or two days prior to the time when Opposer would have been first permitted to file its Rule 11 motion upon expiration of the “safe harbor” period.** This obviously is not how Rule 11 and TTAB rules were intended to be utilized and Opposer therefore requests that Applicant’s January 13, 2015 Motion for Leave to Amend be

denied so that Opposer's Motion for Rule 11 Sanctions (filed concurrently herewith) may be ruled upon by the Board. If the Board rules otherwise, Opposer submits that Applicant would then have free reign to file motions for leave to amend into eternity to continually avoid a hearing regarding Rule 11. This is the exact sort of frivolous delaying tactic that Rule 11 is intended to prevent.

## **B. Argument**

At this stage of the pleadings, under TBMP 507.02, leave to amend may freely be given by the Board "when justice so requires." Under the circumstances at hand, "justice" certainly does not require the granting of Applicant's motion for the following reasons. First, in his motion for leave to amend, Applicant conveniently omits the history of correspondence between the parties that ultimately lead to Applicant's last minute attempt to file for leave to amend his answer. On December 30, 2014, Applicant sent a letter to Opposer entitled "Permission to File Amended Pleading" (Copy attached as **Exhibit A**) which was forwarded in response to Opposer's draft Rule 11 motion that was served on Applicant on December 19, 2014. The letter essentially asks for Opposer's unrestricted consent for Applicant to file an amended answer. On January 9, 2015, after considering Applicant's proposal, Opposer forwarded a reply letter to Applicant (attached as **Exhibit B**) which outlined a reasonable compromise with regard to review of Applicant's proposed amended answer before filing with the TTAB. Applicant's counsel did not reply to the January 9, 2015 letter of Opposer and instead elected to file the instant motion for leave to amend just before Opposer would be permitted to file its Rule 11 motion and obtain a ruling from the Board.

With Applicant's proposed Amended Answer filed on January 13, 2015, the concerns outlined by Opposer in its January 9<sup>th</sup> letter to Applicant turned out to be very well founded as

Applicant left the offending paragraph 7 in similar condition and continues to dance around an admission or denial of the allegations in a frivolous manner that can only be interpreted as an attempt to drive up the costs associated with this litigation. If Applicant's motion is granted, it will force Opposer to file a renewed/amended Motion for Rule 11 sanctions with a new "safe harbor" period as essentially all of Opposer's asserted violations remain. This potential "merry-go-round" of motions (as referenced in Opposer's Jan. 9<sup>th</sup> letter) could conceivably go on for eternity if Applicant is permitted to pursue this course of action. Applicant's strategy is patently an attempt to game the TTAB's rule 11 procedure because it was filed a day or two before Opposer would have been permitted under the rules to file its Rule 11 motion. Applicant made no attempt other than his initial December 30<sup>th</sup> letter to resolve this issue which is not a good faith effort on his part. Under these facts, justice requires that Applicant's motion for leave to amend filed on January 13, 2015 be **denied** as the sole purpose of the motion is to avoid having the Board rule on Opposer's Motion for Rule 11 sanctions that just recently exited the "safe harbor" period provided under the rules. Applicant's hands are clearly unclean under these facts as he didn't even attempt to negotiate regarding Rule 11 matters after Opposer forwarded its reply letter of January 9<sup>th</sup> which outlined a very reasonable compromise on the matter.

### **C. Rule 11 Motion Filed Concurrently Herewith**

An additional rationale for the denial of Applicant's motion for leave to file an amended answer is Opposer's Rule 11 motion filed concurrently herewith. As discussed above, Opposer submits that Applicant is attempting to avoid a ruling on Opposer's now ripe Rule 11 motion by filing his motion for leave to amend just before the end of the Rule 11 "safe harbor." Now that the safe harbor period has ended, Opposer is filing concurrently herewith its Motion for Rule 11

Sanctions. Having the Board rule on Opposer's Rule 11 motion now, and denying Applicant's motion for leave to amend will serve the interest of judicial economy as it will provide earlier closure to the question of whether Applicant has violated Rule 11. In addition, it will lead to a more prompt decision regarding whether the opposition will be sustained at this time, or if the Board will issue a sanctions order requiring Applicant to amend his answer to get it into conformity with Rule 11.

**D. Conclusion**

Given the foregoing arguments and evidence, Opposer respectfully requests that Applicant's January 13, 2015 motion to amend his answer be denied so that the Board may issue a ruling on whether Applicant's October 17, 2014 answer violates Rule 11.

DATED this 23<sup>rd</sup> day of January, 2015.

Respectfully submitted,

BODY VIBE INTERNATIONAL, LLC

By: 

Thomas P. Philbrick, Esq.  
John E. Russell, Esq.  
Attorneys for Opposer

ALLMARK TRADEMARK®  
2089 Avy Ave.  
Menlo Park, CA 94025

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Email: tom@allmarktrademark.com  
allmarktrademark@gmail.com

# EXHIBIT A

**MARK S. HUBERT, P.C.**  
Patent Prosecution & Intellectual Property Litigation

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2300 SW First Avenue, Suite 101  
Portland, OR 97201  
Telephone: (503) 234-7711

December 30, 2014

Thomas P. Philbrick  
Allmark Trademark  
2089 Avy Ave.  
Menlo Park, CA 94025

Mr. Philbrick;

**RE: Permission to File Amended Pleading**

I am in receipt of your proposed Motion for Rule 11 Sanctions, dated December 19, 2014. It appears that I did not address what you consider an allegation in paragraph 7 of your First Amended Notice of Opposition. Since it was contained in quotation marks, and prefaced with "See" I did not treat it as anything other than a reference.

I have prepared Applicant's First Amended Answer to First Amended Notice of Opposition and I am prepared to file it, however since more than 20 days have passed pursuant to FRCP 15(a) and TBMP 507.02 I may amend its pleading only by written consent of every adverse party or by leave of the Board. I am assuming that you have, or are giving me this written consent in paragraphs 1 and 2, pages 4 and 5 of your Opposer's Motion for Rule 11 Sanctions With Regard to Applicant's Answer Filed on October 17, 2014.

Please confirm if this is the case. Upon confirmation I will file the amendment as unopposed and preface it with a statement as to your written permission.

Cordially,



Mark S. Hubert

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Mark S. Hubert\*♦  
markhubert@pacifier.com

Nicole E. Hyatt♦  
nicoleh@pacifier.com

\*Oregon State Bar Member  
♦Registered to Practice Before the USPTO



**CERTIFICATE OF SERVICE**

The undersigned does hereby certify that on this 30<sup>st</sup> day of December 2014, a true and correct copy of this letter (**RE: Permission to File Amended Pleading**) in Opposition 91215512 has been served upon the Attorney for Opposer by mailing the same by U.S. Mail, first-class, postage paid, to the Attorney at his address of record, as follows:

Thomas P. Philbrick  
Allmark Trademark  
2089 Avy Ave.  
Menlo Park, CA 94025

And By email to tom@allmarktrademark.com

By: 

Mark S. Hubert, OSB No. 982564

Mark S. Hubert P.C.

2300 SW First Ave, Suite 101

Portland, OR 97201

Telephone: (503) 234 7711

markhubert@pacifier.com

Attorney for Applicant, David Cox

## EXHIBIT B

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**ALLMARK TRADEMARK ®**

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*2089 Avy Ave.  
Menlo Park, CA 94025  
Telephone: 650-233-2789  
Fax: 650-233-2791*

January 9, 2015

**VIA FIRST CLASS MAIL and EMAIL TO markhubert@pacifier.com**

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW 1<sup>st</sup> Ave., Suite 101  
Portland, OR 97201

**Re: David Cox's request for permission to file Amended Answer Pleading in Dr.  
Vape trademark opposition number 91215512**

Dear Mr. Hubert,

We are in receipt of your December 30, 2014 letter with the caption of "RE: Permission to File Amended Pleading." We appreciate your apparent willingness to attempt to resolve the Rule 11 violations contained in your October 17, 2014 answer to first amended opposition. However, your December 30<sup>th</sup> letter only indicates a willingness to amend the answer relating to the referenced FaceBook allegation. While certainly one of the problems with your amended answer, it certainly isn't the only violation as discussed in our draft motion for Rule 11 sanctions.

Our concern with simply granting my client's unconditional consent for you to file an amended answer is that given your December 30<sup>th</sup> letter, your amended answer sounds like it would almost certainly contain what in our view are similar and/or identical Rule 11 violations with perhaps the only cure being in relation to the allegation regarding your clients FaceBook page. This would leave my client in the predicament of seeing your amended answer only upon its filing and then having to draft a different and revised Rule 11 motion for service on your office, with a renewed waiting period before service at the TTAB. This obviously isn't practical nor what is contemplated under the Rule 11 procedure.

In an effort to avoid the anticipated merry-go-round of revised and resubmitted Rule 11 Motions, Body Vibe suggests what it believes to be a reasonable compromise. In an effort to resolve this Rule 11 issue short of TTAB intervention, Body Vibe requests that it be permitted to review your proposed amended answer draft before it is submitted at the TTAB. If Body Vibe believes the Rule 11 issues to be cured in the draft amended answer, then it will provide its consent for the filing of the amended answer. On the

other hand, if any of the Rule 11 issues outlined in its draft motion for Rule 11 sanctions remain, then it will not provide its consent and will instead proceed with the filing of the motion at the TTAB.

To be clear, under Rule 11, Body Vibe is entitled to admissions or denials of the allegations in paragraph 7 that are presented in a good faith manner, not simply evasive statements such as "said YouTube video exists." To comply with the spirit of Rule 11, everything contained in paragraph 7 needs to be expressly admitted or denied in a clear manner so that Body Vibe knows where Mr. Cox stands. Further, Mr. Cox's catch-all denial in paragraph 15 of its October 17<sup>th</sup> answer needs to be clarified to determine if he is denying significant portions of Body Vibe's paragraph 7 of its amended notice of opposition.

We trust that Mr. Cox is agreeable to Body Vibe's request to review the proposed amended answer before consent to file can be contemplated. Please provide your response and the amended answer draft by 5pm Pacific Time on January 14<sup>th</sup>, otherwise Body Vibe will proceed with the filing of the Rule 11 motion with the TTAB. Please call or email with any follow up questions that you may have. Thank you.

Sincerely,

A handwritten signature in black ink, appearing to read "Thomas P. Philbrick", written over a horizontal line.

Thomas P. Philbrick, Esq.

John E. Russell, Esq.

ALLMARK TRADEMARK ®

Attorneys for Body Vibe  
International, LLC

Phone: (650)233-2789

Email: tom@allmarktrademark.com

CC: Body Vibe International, LLC

**Tom Philbrick**

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**From:** Tom Philbrick [tom@allmarktrademark.com]  
**Sent:** Friday, January 09, 2015 4:23 PM  
**To:** 'Mark Hubert'  
**Subject:** RE: Rule 11 Sanctions  
**Attachments:** Reply to Mark Hubert letter dated Dec 30th re amended pleading and Rule 11 01092015.pdf

Dear Mr. Hubert,

Please find attached Body Vibe's reply to your December 30<sup>th</sup> letter. We look forward to hearing from you.

Sincerely,

Tom Philbrick  
Attorney at Law

ALLMARK TRADEMARK  
Phone: (650)233-2789  
[www.allmarktrademark.com](http://www.allmarktrademark.com)

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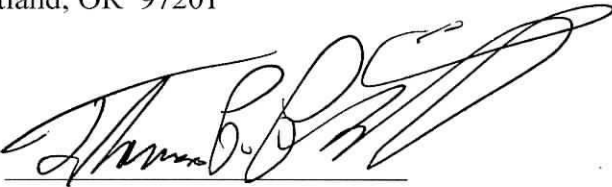
**From:** Mark Hubert [mailto:markhubert@pacifier.com]  
**Sent:** Tuesday, December 30, 2014 5:08 PM  
**To:** Tom Philbrick  
**Subject:** Rule 11 Sanctions

### **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR LEAVE TO AMEND ANSWER (filed on 01/13/2015) TO OPPOSER'S FIRST AMENDED OPPOSITION** has been served on Applicant's attorney of record by mailing said copy on January 23, 2015 via First Class Mail, postage fully prepaid to:

Mark S. Hubert, P.C.  
Attn: Mark S. Hubert, Esq.  
2300 SW First Ave., Suite 101  
Portland, OR 97201

By: \_\_\_\_\_



Thomas P. Philbrick

Dated: \_\_\_\_\_

01/23/2015